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REMARKS

Claims 1-19 and 23-27 are currently pending in the subject application and are presently under consideration. Applicants' representative acknowledges that claims 12 and 15-17 are allowable if recast in independent form to include all limitations of the respective base claim. It is believed such amendments are not necessary in view of the below-noted deficiencies of the cited reference *vis a vis* the claimed invention. However, applicants' representative reserves the option to amend such claims into independent form at a later date, if necessary. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1, 7-8 and 13-14 Under 35 U.S.C. §103(a)

Claims 1, 7-8 and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* (US 6,236,974). Withdrawal of this rejection is respectfully requested for at least the following reasons. Kolawa, *et al.* does not teach or suggest all the claim limitations of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference* (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j).

Independent claim 1 recites a personal shopping system comprising at least one *portable shopping terminal* (to facilitate shopping transactions *via* scanning bar codes) that *resides at a shopping facility* or at a remote location such as a user's home. Kolawa, *et al.* does not teach or suggest the *portable shopping terminal* claimed in the subject invention, but instead discloses a *home automatic maid system* which "performs all of the *selection and organization* tasks involved with family *meal planning*." (See Abstract) (Emphasis added). As disclosed in Kolawa, *et al.*, the automatic maid system comprises a *kitchen mounted* conventional computer 10 that is connected to store servers, a remote control system and information servers *via* an

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Internet connection (network 40) and respective interfaces (delivery subsystem 60, remote access device 70 and information update subsystem 50, respectively). (See col. 3, ll. 1-9 and ll. 23-26). The automatic maid receives family meal preferences, retrieves recipes, determines compatible meals (*via* a vector with family meal preferences) and orders products. (See Abstract).

The Examiner contends that the store servers, remote control system and information servers of Kolawa, *et al* disclose the *portable shopping terminal* recited in the subject claims; however, such servers and remote system do not teach or suggest the claimed *portable shopping terminal*. In general, the store servers, remote control system and information servers are employed to search a store's inventory for products, interact with the kitchen computer from work and update the kitchen computer software and data, respectively. More particularly, the store servers are utilized to facilitate fulfilling a request for products by providing *home access* to a store's product inventory. Kolawa, *et al* discloses that a request for a product is transmitted *from the kitchen computer* over the network, wherein the product request is compared against a product database to determine whether the product is available; and if it is available, then the product is added to the user's list of products to purchase. (See col. 4, ll. 10-23). The remote control system provides a user the ability to communicate with the *conventional computer in the kitchen* from a remote location. Kolawa, *et al* discloses that the remote control system can be software executing on a user's computer at work such that the user can provide instructions to the automatic maid from work. (See col. 3, ll. 52-67). The information servers are utilized to update the *kitchen computer* with information. Kolawa, *et al* discloses that such information includes new recipes and menus and kitchen maid software. (See col. 3, ll. 33-51).

In contrast, the *portable shopping terminal* recited in independent claim 1 of the subject application facilitates shopping by providing a user with a portable device to scan bar codes associated with products at a shopping establishment. As disclosed, the portable shopping terminal can comprise a two-way data interface (*e.g.*, a laser or CCD bar code reader) configured to read bar codes (*e.g.*, upon a user activating a trigger or swiping the product) and a memory to store data associated with the bar codes. Bar code data can be transmitted to the portable shopping terminal and scanned product bar codes can be retrieved from the portable shopping terminal when it is in an associated kiosk cradle located at home or *at the shopping establishment*. (See p. 6, l. 10 – p. 7, l. 16; p. 22, ll. 7-18 and p. 32, ll. 10-14).

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In addition, the Examiner contends that Kolawa, *et al* "obviously discloses a remotely [sic] terminal by showing 'For instance, the preference vectors may be stored at an offside server along with a unique ID. When access to a particular preference vector is desired ...'" It is respectfully submitted that the preference vector does not make obvious the remotely located *portable shopping terminal* of the claimed invention. The preference vector, as disclosed in Kolawa, *et al*, provides a numerical representation of a family's eating preferences, wherein each position of the preference vector corresponds to a particular preference. For example, one position in the preference vector can indicate that the family is vegetarian (*e.g.*, via entering "0" or "1" in the position associated with vegetarianism), while other positions in the preference vector can indicate the family's preferred type of food (*e.g.*, via entering "2" in the position associated with Italian food and a "6" in the position associated with Mexican). (See col. 4, l. 36 - col. 5, l. 3; and FIG. 2). Thus, the preference vector apprises the automatic maid (via CS 11) of the family's *meal preference* to facilitate "the *selection and organization* tasks involved with family *meal planning*." (Emphasis added). In contrast, and as noted *supra*, the *portable shopping terminal* recited in the subject claims comprises a bar code reading mechanism that allows a user to scan items at a shopping establishment, and can reside *at the shopping facility* or at a location remote from the facility, for example at the user's home.

Moreover, there is no suggestion or motivation to provide a *home automatic meal planning system* with the bar code reading functionality of the *portable shopping terminal* of the claimed invention since the *automatic meal planning system* resides on a conventional pc mounted at a *user's home* and *automatically places orders* for the user rather than having the user go to the shopping establishment. Thus, the system of Kolawa, *et al* inherently teaches away from facilitating a user with selecting items while at the shopping establishment since any orders, if any, are placed *via* the home computer mounted in the kitchen. As provided pursuant MPEP §2143.01, the mere fact that the cited reference can be modified does not render the result obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In addition, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

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From the above, and contrary the Examiner's contentions, Kolawa, *et al* does not teach or suggest a *portable shopping terminal*, as recited in the subject claims, that can be utilized *at a shopping establishment* to purchase items *via scanning bar codes*, but rather a *home* automatic maid system to *select and organize family meals* through a *conventional computer mounted in a user's kitchen*. Therefore, it is respectfully requested the rejection of independent claim 1 (and claims 7-8 and 13-14, which depend therefrom) should be withdrawn.

II. Rejection of Claim 19 Under 35 U.S.C. §103(a)

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.*, in view of the Official Notice. Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 19 depends from independent claim 1, and the Official Notice regarding finger-print identification does not make up for the aforementioned deficiencies of Kolawa, *et al.* with respect to teaching or suggesting a *portable shopping terminal*, as recited in independent claim 1. Therefore, it is respectfully submitted that this rejection be withdrawn.

III. Rejection of Claims 23-27 Under 35 U.S.C. §103(a)

Claims 23-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.*, in view of the Official Notice. Withdrawal of this rejection is respectfully requested for at least the following reasons. Independent claim 23 recites limitations similar to the limitations in independent claim 1, and the Official Notice fails to make up for the aforementioned deficiencies of Kolawa, *et al.* with respect to teaching or suggesting a *portable shopping terminal*, as recited in independent claim 1. Accordingly, the rejection of independent claim 23 and claims 24-27, which depend therefrom, should be withdrawn.

IV. Objection of Claims 12, 15-17 Under 35 U.S.C. §103(a)

Claims 12 and 15-17 stand objected to as being dependent on a rejected base claim. This objection should be withdrawn for at least the following reasons. Claims 12 and 15-17 depend from independent claim 1, which is believed to be allowable for the aforementioned reasons. Accordingly, withdrawal of this objection is respectfully requested.

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CONCLUSION

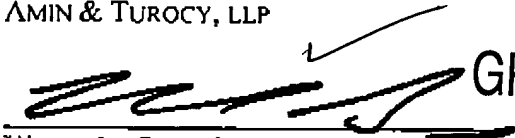
The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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